

**REMARKS**

Claims 1, 2, 4, 6, 7, 9, 11, 12, 14, 16-19 and 21 are pending.

Claims 1, 2 and 16 are independent claims.

**INTERVIEW**

The courtesy of the Examiner in conducting an interview on July 15, 2003 is appreciated.

The Interview Summary does correctly summarize the interview. Also, at the interview, the reference to Keys was also discussed and reviewed. It was understood that the amendments to the claims may overcome the rejection under 35 U.S.C. 102. It was understood that the Examiner would make a final determination when the official Reply is received.

**Information Disclosure Statement**

There was an Information Disclosure Statement filed February 7, 2002. There is no record that the Examiner considered the documents cited on that Information Disclosure Statement have been considered by the Examiner. The Examiner is requested to return an initialed copy of the PTO form 1449 that was submitted with the Information Disclosure Statement of February 7, 2002.

**Entry of the Amendment**

It is requested that the amendments to the claims be entered as they reduce issues for appeal by canceling claims and is submitted they do not raise any new issues.

**Objection to the Drawings**

A new objection was made to the drawings. Accompanying this Reply is a Letter for Correcting the Drawings including a marked-up copy in red of the Figures to be corrected. With respect to figure 2, as the legends on the outside and inside, the cabin describe the x-axis, it is requested that the Examiner withdraw this requirement and allow the legends. See 37 C.F.R. 1.84(a).

The Examiner is requested to approve these drawing corrections and they will be made within the time period set by the Patent Office.

**Objection to the Abstract**

The Abstract was objected to for the reasons set forth on pages 2 and 3 of the Office Action. A new Abstract has been provided.

The Examiner is requested to reconsider and withdraw the objection to the Abstract.

**Reply to Rejections****First Rejection**

Claims 1-22 was rejected under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter, which Applicant regards as the invention. This rejection as to the remaining claims is traversed.

The claims have been amended and do comply with 35 U.S.C. 112.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 U.S.C. 112, second paragraph.

**Second Rejection**

Claims 1 and 6 were rejected under 35 U.S.C. 102(b) as being anticipated by Keys, (U.S. Patent 5,217,786). This rejection is traversed.

While element 10, in Keys is not shown in the drawings, it is described in the specification and it is understood what the Examiner was referring to.

With respect to Keys, the Examiner asserts that both of the lip 28 and 48 would remain in contact with the windowpane 14 even during vibration of the windowpane.

In the present invention, one lip portion 3c has length set so that, when other lip portion 3d is bottomed with one inner wall face 3f, the lip portion 3c may not be spaced away from said door glass 2, and the other lip portion 3d

have length set so that, when the one lip portion 3c is bottomed with one inner wall face 3e, the lip portion 3d may not be spaced away from said door glass 2.

Compared that, to Keys, it is only speculation that lip 28 would remain in contact with the windowpane 14 when other lip 48 is bottomed with a inner wall face.

Accordingly, the claims are not anticipated by the reference.

This rejection was under 35 U.S.C. 102, and apparently the Examiner is relying on inherency in rejecting the claims. Inherency cannot be established by possibility or probability. Even for the sake of argument, if it were possible or probable that the lip portions in the references have the lengths individually set to perform the function, which they do not, a rejection under 35 U.S.C. 102 cannot be based on possibility or probability. See *Continental Can Co., USA, Inc. v. Monsanto Co.* 20 USPQ 2<sup>nd</sup> 1746, 1749 (Fed. Cir. 1991) (cited also in the MPEP) wherein the Court stated as follows:

Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. . .

With respect to claim 6, this claim is considered patentable at least for the same reasons as its base claim 1.

Also, outside of the Applicants disclosure, there is no motivating reason to modify the reference to arrive at the context claimed.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 U.S.C. 102.

### Third Rejection

Claims 2-5 and 7-10 were rejected under 35 U.S.C. 102(b) as being anticipated by Keys. This rejection as to the remaining claims is traversed. Base claim 2 has been amended and is not anticipated by Keys.

With respect to the remaining claims, these are dependent claims, depending initially on base claim 2. Accordingly, these claims are considered patentable, at least for the same reasons as their base or intervening claims.

Also, outside of the Applicants disclosure, there is no motivating reason to modify the reference to arrive at the context claimed.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 U.S.C. 102.

### Fourth Rejection

Claim 11 was rejected under 35 U.S.C. 103(a) as being unpatentable over Keys as applied to claims 1, 6, 16 and 17 above. This rejection is traversed.

The Examiner correctly recognizes that Keys is silent concerning a particular depth of the notch portion. The Examiner then asserts that this is "obvious matter of engineering design". This statement is traversed.

When the notch portion is set equal to or smaller than .5mm, the advantages of the notch can be achieved with certainty. See, for example, the first two paragraphs of page 7 of the specification. Accordingly, this is more than "engineering design", because what has been achieved is an optimum value to provide the function. There is nothing in the art that would suggest

this. It may be while one skilled in the art is capable of doing this, capability does not equate to obviousness. See *Ex parte Levingood*, 28 USPQ 2<sup>nd</sup> 1300 (BPAI 1993) (also cited in the MPEP at section 2143.01, right column).

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claim under 35 U.S.C. 103.

#### Fifth Rejection

Claims 12-15 and 19-22 were rejected under 35 U.S.C. 103(a) as being unpatentable over Keys as applied to claims 2-5 and 7-10 above. This rejection as to the remaining claims is traversed.

Again, the depth that has been claimed is 0.5mm. As explained in the reply to the rejection of claim 11, this is important. The comments regarding in the rejection of claim 11 set forth above are incorporated herein.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 U.S.C. 103.

#### **CONCLUSION**

In view of the response above, no further comments are considered necessary.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Elliot A. Goldberg (Reg. No. 33,347) at the telephone number of the undersigned below, to

conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully Submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By: 

Charles Gorenstein

Reg. No. 29,271

P.O. Box 747

Falls Church, VA 22040-0747

(703) 205-8000

CG/EAG/kss